



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/586,131	06/02/00	DELCOURT	M 1184-00

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IP DEPARTMENT
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EXAMINER

PRASTHOFFER, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/586,131

Applicant(s)

DELCOURT, MARC

Examiner

Thomas W Prasthofer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000 and 24 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Detailed Action

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, and 19 drawn to a process for isolating an intact clone of one target nucleic acid fragment having a known characteristic, classified in class 435, subclass 6.
 - II. Claims 16, 17, and 19 drawn to a process for isolating an intact clone of one target nucleic acid fragment having a known characteristic, classified in class 435, subclass 6.
 - III. Claims 18 and 19, drawn to a process for isolating an intact clone of one target nucleic acid fragment having a known characteristic, classified in class 435, subclass 6.
 - IV. Claim 20, drawn to a group of monodigested libraries, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because:

2. Inventions I, II, and III are different and patentably distinct methods (processes) for isolating an intact clone of one target nucleic acid fragment having a known characteristic. Each method includes method steps not present in the other two methods and each method produces a different product. For example, Invention I includes the step of screening a group of monodigested libraries (that are not transfected) and produces a multi-digested library (that is not transfected). Invention II includes the steps of verifying the presence of a target fragment and screening transfected monodigested libraries and produces a transformed multi-digested library. Invention III includes the steps of transforming monodigested libraries into bacteria (not independently), culturing said bacteria to produce digested libraries substantially free of cleaved

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products, depositing said products in an agarose gel well, migrating said products, transferring said products onto a membrane, and hybridizing said transferred products with a probe.

Invention III produces a multi-digested library having an intact clone of the target nucleic acid fragment.

3. Inventions I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the group of monodigested libraries of Invention IV can be made by another and materially different process from the method of Invention I, namely, the process of Invention II or Invention III.
4. Because these inventions are distinct for the reasons given above and
 - a. have acquired a separate status in the art as shown by their different classification ;
 - b. have different and separately burdensome: manual and/or computer: structure, name and bibliographical searches; and
 - c. have divergent subject matter, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under CFR 1.17(h).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas W. Prasthofer** whose telephone number is **(703) 308-4548**. The examiner can normally be reached on Monday-Friday, 8:00-4:30.
8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.
9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Thomas Prasthofer, Ph.D.

03/01/01

BENNETT CELSA
PRIMARY EXAMINER

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